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From: Raymond Garguilo, Jr.

Date: September 17, 2004 No. Pages: 3 (including this page)

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• MESSAGE:

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Raymond Garguilo, Esq.

Signature

Date: September 17, 2004

To: U.S.P.T.O.

Attention: B.K. Talbot

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No. of Pages 2

Docket No.: TESSERA 3.0-176 DIV
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Beroz et al.

Application No.: 09/942,386

: Group Art Unit: 1762

Filed: August 30, 2001

: Examiner: B. K. Talbot

For: COMPONENTS WITH CONDUCTIVE
SOLDER MASK LAYERS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMUNICATION

Dear Sir:

As per our telephone interview on April 5, 2004, and subsequent telephone conversations including one on September 14, 2004, we have recently realized that *DiStefano et al.* United States Patent Number 6,324,754 ("*DiStefano*") which is cited under 35 U.S.C. § 102(e) as being prior art against the above identified matter, does not qualify as prior art.

Specifically, DiStefano has a filing date of March 25, 1998, while the above-identified matter has a priority date of March 26, 1998, one day after the filing date of DiStefano. Thus, DiStefano does not qualify as 35 U.S.C. § 102(b) prior art since it was published less than

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one year prior to the filing of the above-identified matter. Secondly, DiStefano also does not qualify as prior art under 35 U.S.C. § 102(e) since it is commonly owned by the same inventive entity of the above identified matter at the time of the invention.

In order to simplify matters, we request that the rejection under 35 U.S.C. 103 (a) for which DiStefano is cited be withdrawn.

If you have any further questions, please do not hesitate to contact us.

Dated: September 17, 2004

Respectfully submitted,

By 

Raymond Garguilo, Jr.

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